

SIEMENS

PATENT

Attorney Docket No. 2002P00241WOUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

| | | | |
|-------------|---------------|---|------------------------------|
| Inventor: | Peter Tiemann |) | Group Art Unit: 3746 |
| | |) | |
| Serial No.: | 10/524,523 |) | Examiner: Gerald Luther Sung |
| | |) | |
| Filed: | 02/11/2005 |) | Confirmation No. 1108 |

Title: GAS TURBINE COMBUSTION CHAMBER

Mail Stop Appeal Brief - Patent
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANTS' REPLY BRIEF UNDER 37 CFR 41.41

This reply brief is in response to Examiner's Answer of 07/18/2008. This is not a substitute Appeal Brief. Any ground for rejection in Examiner's Answer that is not refuted herein is considered by Appellant to have been sufficiently argued in the Appeal Brief, such that no further comment is needed herein. Arguments herein focus only on particular errors in the Examiner's Answer.

1) Regarding the rejection of claim 8 under 35 USC 103(a), the Examiner attempts at page 9 of the Answer to provide a motivation for supplying the "fourth limitation" of claim 8 that is missing from the 3-way prior art combination of Babcock, Albrecht and DuBell. That limitation is "wherein the inner cooling chamber of the manhole cover is connected for fluid flow purposes to the wall cooling chamber of the combustion chamber wall." The Examiner admits that this limitation is missing from the combination of prior art references, but states on page 9 that "one of ordinary skill in the art at the time of the invention would have recognized that a single cooling circuit with a common cooling fluid would have provided a more uniform temperature across the combustion chamber than a cooling system comprising of two independent systems."

The Examiner's statement, and therefore his conclusion of obviousness based upon his statement, is conjecture without technical support. There is no technical basis in the record supporting the conclusion that a single cooling circuit would provide a more uniform temperature across the combustion chamber. Just the opposite may, in fact, be true, since a cooling fluid experiences a rise in temperature as it flows through a single cooling circuit and therefore provides a different level of cooling between its upstream and downstream portions. Conversely, by supplying multiple cooling circuits that each traverse a shorter distance across the combustion chamber, a more uniform coolant temperature is maintained and a more uniform combustion chamber temperature may be possible. The Appellant is not arguing that one or the other technical position is correct, but rather, the Appellant is demonstrating that the Examiner's statement is without technical support, and therefore it provides no *prima facie* support for a person skilled in the art to supply the missing "fourth limitation" that is missing from the three cited prior art references.

2) On page 10 of the Answer, the Examiner discusses the claim 11 limitation of the "inner cooling chamber of the manhole cover is directly connected to the wall cooling chamber of the combustion chamber wall by inserting the manhole cover into the manhole." This limitation further limits the "fourth limitation" of claim 8 by requiring the connection between the inner cooling chamber of the manhole cover and the wall cooling chamber of the combustion chamber wall to be directly connected ... by inserting the manhole cover into the manhole. No such limitation is found in the three cited prior art patents. The Examiner not only finds the

claimed connection between the manhole cover cooling chamber and the wall cooling chamber to be obvious in support of the rejection of claim 8, he further states on page 10 that the additional claim 11 limitation of being "directly connected ... by inserting the manhole cover into the manhole" is inherently provided in the untaught but obvious connection. This position is in error because a) this is an inappropriate extension of the inherency concept, and b) there are multiple ways to make the claimed connection, so the specifically claimed direct connection can not be said to be inherent.

a) The inherent teaching of a reference is appropriate for supporting a rejection under 35 USC 102 or 103 based upon the *Verdegaal Bros. v Union Oil Co. of California* decision cited in MPEP 2131 that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." However, what the Examiner is doing on page 10 of the Answer is not to rely upon the inherency of a reference, but rather, to rely upon the inherency of a relationship that is absent from the cited references but that the Examiner finds as being obvious beyond the references.

b) As discussed in *Continental Can C. USA v. Monsanto Co.* discussed in MPEP 2131.01.III, inherency is appropriate only when "the missing descriptive matter is necessarily present in the thing described in the reference." Since no connection between a manhole cover cooling chamber and a wall cooling chamber is described in the references, the claimed direct connection by definition can not necessarily be present. Furthermore, even if the prior art would have mentioned such a connection, there would be multiple ways to achieve such a connection, so the specific claim 11 limitation of being "directly connected ... by inserting the manhole cover into the manhole" would not necessarily be present. While no specific structural details are enumerated in claim 11, the claim must be read in light of the teaching of the specification, and thus only structures that accomplish the claimed function (i.e. that directly connect the two chambers when the manhole cover is inserted into the manhole) would be within the scope of the claim.

3) On page 11 of the Answer, the Examiner contends that the seal that is located between the door and the wall of Stanke "must be capable of supporting some load, even if the load approaches zero" and therefore that it anticipates the claim 12 "fixing element." However, it is an error and technically inaccurate to suggest that the flexible seal of Stanke could function as a

supporting element, in spite of the fact that any physical object can support "some load, even if the load approaches zero." Such an argument is akin to saying that an ounce of water raises the level of the Pacific Ocean. One skilled in the art clearly understands that the flexible seal of Stanke is not a supporting structure.

Conclusion

For the reasons provided in Appellant's previously filed Brief and in this Reply Brief, Appellants respectfully submit that the rejections set forth in the final Office Action are inapplicable to the pending claims. The honorable Board is therefore respectfully requested to reverse the final rejection of the Examiner and to remand the application to the Examiner with instructions to allow the pending claims.

Respectfully submitted,

Dated: 9/17/08

By: 

John P. Musone
Registration No. 44,961
(407) 736-6449

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830